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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/762,843

01/21/2004

Cedora Ruiz

RUIZ.0001P

5864

7590

05/05/2006

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Casper, WY 82064

EXAMINER

WALCZAK, DAVID J

ART UNIT

PAPER NUMBER

3751

DATE MAILED: 05/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

10/762,843

Applicant(s)

RUIZ, CEDORA

Examiner

David J. Walczak

Art Unit

3751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claim 17 is objected to because of the following informalities: On line 2 of claim 17 "opening interior" should be --open interior--. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10, 12, 13 and 14 remain rejected under 35 U.S.C. 102(b) as being anticipated by Siegel (as cited by Applicant). In regard to claims 10 and 12, Siegel discloses a writing pen comprised of a cylindrical, transparent housing 23 having a closed interior, a tip for dispensing ink stored in a well 13 and a plurality of solid "ornamental elements" 20, 22, 11, 14 substantially filling the interior bounded between the exterior of the well and the interior of the housing such that the well is "generally" obscured and only ornamental elements are visible through the housing. In regard to claims 13 and 14, viewing Figure 1, there are three layers of ornamental elements (20, 11, 14) layered in the space between the well and the housing.

Claims 10, 12 and 15-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Dirks (as cited by Applicant). In regard to claims 10 and 12, Dirks discloses a writing implement having a transparent, cylindrical housing 30, a tip for dispensing ink from an inkwell 15 and "ornamental elements" 24, 40 substantially filling the area bounded between the exterior of the well and the interior of the housing such that the well is "generally" obscured and only ornamental elements are visible through the housing. In regard to claims 15 and 16, the ornamental elements 40 are contained within the housing, but not connected to the housing, such that they may move relative to each other (see column 2, lines 37-44). In regard to claim 17, the tip 11 extends from and closes a first end of the housing 30 and the interior of the housing 23 "is defined solely by the housing" such that the ornamental elements are located between the tip and the second end 12 of the housing. In regard to claim 18, the housing 30 comprises a single wall which defines the interior space (having elements 24, 40, 15 therein).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dirks.

The ornamental elements in the Dirks device comprise balls 40. Although the Dirks reference does not disclose the diameter of the balls, it is the Examiner's position that it

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would have been obvious to one of ordinary skill in the art at the time the invention was made that the balls can be of any suitable diameter, depending on the overall size of the writing implement, without effecting the overall operation of the device.

Response to Arguments

Applicant's arguments filed 4/24/06 have been fully considered but they are not persuasive. The Applicant contends that Siegel is not applicable against the claims in that sleeve 20 is not located in a space bound by the housing 23 and well 13 but is rather located between the housing 23 and barrel 11. However, the claims call for a plurality of ornamental elements between the housing and the well. As discussed above, as element 11 in the Siegel device is considered to be one of the "ornamental elements" (along with elements 20, 22 and 14), the Siegel device teaches the claimed structure; that is a plurality of "ornamental elements" (11, 14, 20 and 22) bounded in the space between the housing 23 and the well.

The Applicant further contends that Siegel does not disclose multiple layers of ornamental elements but rather a single layer (sleeve 20) is present. As discussed above however, element 20 is not the only "ornamental element" present in the Siegel device. Ornamental elements 20, 11 and 14 clearly define "layers" of such elements.

The Applicant then contends that the Dirk reference is not applicable since the balls 40 are not between the housing and the well but are between the housing and element 24. Similar to the discussion of the Siegel device, however, element 24 is also one of the "ornamental elements" in the Dirk device. Accordingly, Dirk discloses a

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plurality of "ornamental elements" 40, 24 between the housing and the well. Further with respect to Dirk, the Applicant contends that the ornamental elements do not fill the interior area since they are not located adjacent the tip of the well. However, the claims only require that the elements "substantially" fill the interior area. As "substantially" is a broad term open to a wide array of interpretations, the "ornamental elements" in the Dirk device are considered to "substantially" fill the interior area.

Lastly, in regard to claim 17, the Applicant contends that the elements in the Dirk device do fill the area between the tip and the second end of the housing. Claim 17, however, only requires that the elements are "located" between the tip and the second end. Clearly, the elements in the Dirk device are so located.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Walczak whose telephone number is 571-272-4895. The examiner can normally be reached on Mon-Thurs, 6:30- 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on 571-272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David J. Walczak
Primary Examiner
Art Unit 3751

DJW
5/4/06